

November 4, 1998, thereby rendering the *Terminal Disclaimer* unnecessary and inappropriate. Correspondingly, a *Petition Under 37 CFR 1.182 To Withdraw A Terminal Disclaimer* (hereinafter “*Petition to Withdraw*”) was filed on April 8, 1999. The *Petition to Withdraw* was distinctly noted and specifically brought to the Examiner’s attention in an *Amendment* filed on the same date. At page 6 of the *Amendment*, the Applicant stated that “filed herewith is a Petition to Withdraw ... in view of the claim amendments effected since the obviousness-type double patenting rejection was first applied.” However, prior to the USPTO’s consideration and action on the *Petition to Withdraw*, the ‘235 application was allowed and the application issued as the subject U.S. Patent No. 6,180,991 with the *Terminal Disclaimer* of record still in effect.

The errors upon which this reissue is based are as follows:

1. The error of the applicants in failing to ensure proper disposition of the *Petition to Withdraw* during the prosecution of the ‘235 application;
2. The error of the applicants in not withdrawing the ‘235 application from issuance under 37 CFR § 1.313 before the payment of the issue fee;
3. The error of the applicants in not withdrawing the ‘235 application from issuance under 37 CFR § 1.313 after the payment of the issue fee;
4. The error of the applicants in not deferring issuance of the patent under 37 CFR § 1.314 until the outstanding *Petition to Withdraw* was considered; and
5. The error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject ‘991 patent.

The above errors have resulted in rendering the subject ‘991 patent inoperative during its terminal part of the statutory term that extends beyond the expiration date of the patent identified in the *Terminal Disclaimer* of record. In addition, the above errors have also resulted in rendering the subject ‘991 patent inoperative in that it is only enforceable for and during a period that it and the various patents identified in the *Terminal Disclaimer* of record are commonly owned. Furthermore, in failing to withdraw the *Terminal Disclaimer*, the applicant also believes the ‘991 patent is partly inoperative

by reason that the patentee claimed less than the patentee had the right to claim in regards to the term of the '991 patent.

The Official Action continues to refuse the question which was originally put to it, that is, whether the *Terminal Disclaimer* is necessary or unnecessary. There appears to be an utter disregard for procedures promulgated by the Patent Office, namely the processing of a properly filed petition under 37 CFR § 1.182. It appears that the Official Action and prior communications from the Office are more and more clearly becoming arbitrary and capricious, particularly in light of the clear guidance of the MPEP and previous decisions. From the facts of record and noted in the present communication, it is clear that the public was put on notice of Applicant's intent to withdraw the *Terminal Disclaimer*, and that the terminal portion of the '991 patent was never freely dedicated to the public. The present reissue application seeks correction of these errors.

The Official Action asserts that the "reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based" (page 2, Paper No. 2, citing 37 CFR § 1.175(a)(1) and MPEP § 1414). The Applicant respectfully disagrees and traverses the assertion in the Official Action.

37 CFR § 1.175(a)(1) states that the reissue oath must state that "The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent; stating at least one error being relied upon as the basis for reissue." The Applicant respectfully submits that the reissue oath/declaration filed with the present reissue application is not defective; that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent; that the applicant clearly stated at least one error being relied upon as the basis for reissue; and that the errors which are relied upon to support the reissue application are errors upon which a reissue can be based.

Specifically, in the *Reissue Application Declaration by the Inventor*, the Applicant stated the following: "I verily believe the original patent to be wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had the right to claim in the patent ... [and] by reason of other errors." The Applicant presented facts related to the present reissue application and five errors upon which the present reissue is based. Having made such statements in the *Declaration*, the Applicant respectfully submits that the *Declaration* fully complies with 37 CFR § 1.175 and is not defective.

Furthermore, the errors which are relied upon to support the reissue application are unquestionably errors upon which a reissue can be based. Among the errors in question in the present reissue application is the error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject '991 patent. As noted in detail below, the Official Action attempts to characterize the present reissue as merely an attempt to withdraw the *Terminal Disclaimer* after issuance of a patent. The Applicant has not made such an error. By the present reissue, the Applicant is not merely asking the Patent Office to correct the Applicant's error in waiting until after issuance of the patent to withdraw the *Terminal Disclaimer*. Rather, the Applicant seeks correction of an ongoing error, particularly a failure to consider the *Petition to Withdraw* on April 8, 1999, which occurred in between the filing of the *Petition to Withdraw*, persisted until issuance of the case on January 30, 2001, a period of about 21 months, and continues to this day.

MPEP § 1490(A) states that

there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition ... Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer.

On April 8, 1999, 21 months before issuance of the '991 patent, the Applicant properly filed a *Petition Under 37 CFR 1.182 To Withdraw A Terminal Disclaimer*. The Patent Office never acted on this *Petition to Withdraw*, and the present reissue application seeks correction of this error, namely the failure to consider the *Petition to Withdraw*.

The Official Action further asserts that "[as] a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent" (emphasis added, page 2, Paper No. 2, citing Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935)). The Official Action appears to ignore the underlined portion of the above quotation. Again, the Official Action appears to be mischaracterizing the error in the present reissue as an error by the Applicant, namely an error by the applicant in waiting to request withdrawal of the *Terminal Disclaimer* after issuance of a patent. The Applicant respectfully submits that upon filing of the *Petition to Withdraw* on April 8, 1999, the public was on notice that the Applicant did not freely dedicate the terminal portion of the ultimate '991 patent to the public. Furthermore, the Altoona case has nothing to do with terminal disclaimers, and certainly does not address a situation where an Applicant timely and properly petitioned the Office to withdraw a terminal disclaimer prior to issuance of a patent, and where the Office fails to consider the petition. Therefore, the terminal portion of the '991 patent was never freely dedicated to the public. Further, the Applicant respectfully submits that public policy does not favor taking from the patent owner something that has not been freely dedicated to the public. Unless the present reissue examines the error in question, the patent owner will be deprived of something that has not been freely dedicated to the public.

In a *Preliminary Letter* filed with the present reissue application, the Applicant notes the similarities between the present reissue application and the facts in the decision in *Ex parte Durckheimer et al.*, Appeal No. 94-2004, U.S. Application Ser. No.

07/551,615. The Official Action asserts that the present reissue application is distinguishable from the Durckheimer decision. Specifically, the Official Action asserts that a reading of the Durckheimer decision "reveals on page 21 ... that there was 'an unique set of facts and circumstances wherein the claims which were secured by the filing of the terminal disclaimer were canceled before the patent was granted.'" (page 3, Paper No. 2). The Applicant respectfully disagrees and traverses the above assertions in the Official Action. As noted in detail below, it appears that the Official Action has taken page 21 of the Durckheimer decision out of context.

There are three grounds for denying reissue set forth in MPEP § 1490 and reiterated in the Durckheimer decision, and the facts of the present reissue application do not support such grounds for denying reissue. The Applicant submits that a terminal disclaimer does not alter the term of the original patent and that a terminal disclaimer is only a disclaimer of a terminal part of the term of the patent granted or to be granted; therefore, a reissue in the present case does not extend the term of the original patent sought to be reissued under § 251 (*Ex parte Durckheimer et al.*, at 18-21). Also, the Applicant submits that the present reissue application was filed without any changes to the original patent claims; therefore, recapture is not an issue (*Id.*). Further, the Applicant submits that the present reissue application does not seek to challenge the propriety of a double patenting rejection that prompted the *Terminal Disclaimer* sought to be withdrawn; therefore, the above-referenced errors are proper and within the meaning of § 251 (*Id.* at 21-23). Still further, the Applicant submits that some of the errors noted in the present reissue application are inadvertent errors for failure to take advantage of an opportunity of or to follow Office procedure before a patent issues; therefore, such errors are not *per se* a ground for denying reissue (*Id.* at 23-25). Even further, the Applicant submits that the error by the Office in failing to consider the properly filed *Petition to Withdraw* is clearly an error within the meaning of § 251. As such, the present reissue should not be barred.

In fact, the present reissue application is very similar to the Durckheimer decision. At the time of filing the *Terminal Disclaimer* in the present case, the claims were different from the claims as ultimately allowed. In the Official Action, it is implied that the facts of the present application differ from the "unique set of facts and circumstances" (page 3, Paper No. 2, citing page 21 of Durckheimer). The Applicant respectfully disagrees.

In Durckheimer, the claims which were subject to a terminal disclaimer were canceled rendering the terminal disclaimer moot. Also in Durckheimer, the applicants successfully withdrew a terminal disclaimer even after issuance of the patent and even though no attempt was made to request such withdrawal prior to issuance. In contrast, in the present application, the claims of the '235 application were substantively amended on August 14, 1997, November 14, 1997, May 11, 1998, and November 4, 1998, thereby rendering the *Terminal Disclaimer* unnecessary and inappropriate. As such, the claims which were secured by the *Terminal Disclaimer* were no longer pending in the case. Therefore, the Applicant's request to withdraw the *Terminal Disclaimer* should be granted, and the aforementioned errors should be corrected by the present reissue application.

Furthermore, the facts of the present case are even more favorable than in Durckheimer because the Applicant filed a subsequent *Petition to Withdraw* and brought such *Petition* to the attention of the Examiner in a subsequent *Amendment*. Therefore, like Durckheimer, the *Terminal Disclaimer* in the present application does not secure claims that were issued in the '991 patent. Further, the Applicant in the present application took a further step than the applicants in Durckhemier. By submitting the *Petition to Withdraw*, the public and the Office were put on clear notice that the terminal portion of the claims of the present application were not to be freely dedicated to the public.

As in Durckheimer, the *Terminal Disclaimer* was proper at the time it was filed, and the *Terminal Disclaimer* later became unnecessary because of amendments to the

claims. Due to the above-referenced amendments, none of the claims of the issued patent would have been subject to an obviousness-type double patenting rejection. Therefore, the amendments obviated the purpose for which the terminal disclaimer had been originally filed. In Durckheimer, the Board found that a reissue application proceeding was a proper mechanism to withdraw a terminal disclaimer from an issued patent. Specifically, the Board in the Durckheimer case states that when the record establishes that a terminal disclaimer has become unnecessary, an error within the meaning of 35 U.S.C. § 251 may have occurred by the patent applicants' or their appointed representative's failure to petition or to take some other action to nullify or expunge the terminal disclaimer from the application file prior to issuance of a patent (*Ex parte Durckheimer et al.* at 16). It is significantly more clear that an error within the meaning of § 251 has occurred when an Applicant has in fact taken the further step of noting an unnecessary *Terminal Disclaimer* in a petition under § 1.182, that subsequent errors by the applicants or the Patent Office would also constitute errors within the meaning of § 251 and are therefore suitable for a reissue application, and that the public interest has been protected.

Finally, the Official Action concludes that "the original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed" (page 3, Paper No. 2, citing 37 CFR § 1.178). The Applicant respectfully submits that an *Offer to Surrender Patent* was timely filed with the present reissue application and that upon allowance of the present application, the Applicant will submit the original patent as agreed therein.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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